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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,422

12/01/2003

Robert Harwell Thibadeau

1060

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01/26/2007

EXAMINER

MURRAY, DANIEL C

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/724,422

Applicant(s)

THIBADEAU, ROBERT HARWELL

Examiner

Daniel Murray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01DEC2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01DEC2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Drawings*

2. The drawings are objected to because block labels for 3, 4, 5, 9, 16, and 18 are illegible.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "13" and "27" have both been used to designate Network Email Sources.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because of use of the legal phraseology "means" (abstract line 6). Consider replacing "means of" with --method for-- or deleting "a means of".

Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities: an unnumbered page containing the line "this software. The corresponding sequential software states...". It is assumed for the purposes of examination that this line is intended to be the last line of page 8. Thus, future reference to this text during examination will be referenced with respect to the paragraph and line numbers of page 8.

Appropriate correction is required.

8. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

- page 8 paragraph 4 line 5 "The corresponding sequential [server] states [14] of the server [1] are shown in Fig 2."

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- page 9 paragraph 2 lines 1-2 “[Figure 1], the benchmark server 1 presents a web site to the person at [network client 8] as well as specific email [interfaces] 7.
- Page 13 paragraph 2 line 3 “within tolerance set for the normalization suite” where “tolerance” is vague and indefinite.
- Page 13 paragraph 4 line 1 “the standard spam filters” where “standard” is vague and indefinite.

All reference labels and associated numbers mentioned in the specification should be consistent with those mentioned in the drawings. Appropriate correction is required.

### ***Claim Objections***

**Claims 1-9** are objected to because of the following informalities:

- a) On **line 2 of claim 1**, delete “the steps” after “comprising the”.
- b) On **line 3 of claim 1**, delete “a.” before “obtaining” and insert --;-- after “tested”.
- c) On **line 4 of claim 1**, delete “b.” before “validating” and insert --;-- after “tested”.
- d) On **line 5 of claim 1**, delete “c.” before “manufacturing” and insert --;-- after “emails”.
- e) On **line 5 of claim 1**, replace “the” with --a-- before “benchmark” in order to provide proper antecedent basis for “benchmark suite”.
- f) On **line 6 of claim 1**, delete “d.” before “electronically” and insert --- after “address”.
- g) On **line 6 of claim 1**, replace “the” with --a-- before “test” in order to provide proper antecedent basis for “test suite”.
- h) On **line 6 of claim 1**, replace the “tested email address” with --email address to be tested-- in order to provide proper antecedent basis.
- i) On **line 1 of claim 2**, delete “the step” after “including”.

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- j) On **line 2 of claim 2**, delete “a.” before “collecting” and insert “--” after “suite”.
- k) On **line 2 of claim 2**, insert “--test--” before “suite” in order to provide proper antecedent basis.
- l) On **line 1 of claim 3**, delete “the step” after “including”.
- m) On **line 2 of claim 3**, delete “a.” before “customizing” and insert “--” after “suite”.
- n) On **line 2 of claim 3**, insert “--test--” before “suite” in order to provide proper antecedent basis.
- o) On **line 1 of claim 4**, delete “the step” after “including”.
- p) On **line 2 of claim 4**, delete “a.” before “testing” and insert “--” after “suites”.
- q) On **line 2 of claim 4**, insert “--test--” before “suite” in order to provide proper antecedent basis.
- r) On **line 1 of claim 5**, delete “that obtains an email address to be tested and” before “further”.
- s) On **line 2 of claim 5**, replace “includes” with “--including--” and delete “this step” after “includes”.
- t) On **line 3 of claim 5**, delete “a.” before “obtaining” and insert “--” after “validating”.
- u) On **line 1 of claim 6**, delete “that obtains an email address to be tested and” before “further”.
- v) On **line 2 of claim 6**, replace “includes” with “--including--” and delete “this step” after “includes”.
- w) On **line 3 of claim 6**, delete “a.” before “obtaining”.
- x) On **line 4 of claim 6**, insert “--test--” before “suite” in order to provide proper antecedent basis.

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- y) On **line 1** of **claim 7**, delete “the step” after “including”.
- z) On **line 2** of **claim 7**, delete “a.” before “the presentation” and replace “the” with --a-- to provide proper antecedent basis.
- aa) On **line 3** of **claim 7**, delete “the” before “benchmark” in order to provide proper antecedent basis for “benchmark data”.
- bb) On **line 1** of **claim 8**, delete “the step” after “including”.
- cc) On **line 2** of **claim 8**, delete “a.” before “the collecting”.
- dd) On **line 3** of **claim 8**, insert --- after “automatically”.
- ee) On **line 1** of **claim 9**, delete “the step” after “including”.
- ff) On **line 2** of **claim 9**, delete “a.” before “inserting” and insert --test suite-- before “emails” in order to provide proper antecedent basis for “benchmark emails”.
- gg) On **line 4** of **claim 9**, replace “the” with --a-- to provide proper antecedent basis for “email filter”.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what “prior suites” is referring to (benchmark test suites, normalizing suites, standard spam filter suite, etc.) in **line 2**. For the purposes of examination “prior suites” will be interpreted as --prior benchmark test suites--.

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11. Regarding **claim 8**, the word "means" is preceded by the word(s) "using a" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function.

However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 1-4 and 6-9** are rejected under 35 U.S.C. 102(e) as being anticipated by **Goodman et al. (US Patent Publication # US 2005/0015454 A1)**.

a) Consider **claim 1**, Goodman et al. clearly shows and discloses, obtaining an email address to be tested (abstract 1-5 inherently teaches the exchange of email address, figure 2 (link between 210 and 230 indicates the exchange of user information i.e. email addresses), paragraph [0011]); validating the email address to be tested (paragraph [0001] (inherently teaches the use of email validation to hinder spammers), paragraph [0009] lines 7-9 (inherently teaches the use of challenge to validate an email address)); manufacturing the benchmark test suite of emails(paragraph [0041], paragraph [0043] lines 6-7 lines 13-14 (inherently teaches manufacturing email suites for the



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purposes of testing filters), paragraph [0049] lines 6-7 (inherently teaches manufacturing email suites for the purposes of testing filters); electronically mailing the test suite to the tested email address (paragraph [0043] lines 6-7 lines 13-14 (inherently teaches sending emails for the purposes of testing filters), paragraph [0049] lines 6-7 (inherently teaches sending emails for the purposes of testing filters).

b) Consider **claim 2**, and as **applied to claim 1 above**, Goodman et al. further disclose collecting emails (figure 7 (710, 720, subset of training data inherently teaches a collection of emails), paragraph [0026] line 3 (training data inherently teaches a collection of emails), paragraph [0027] lines 13-17 (capture and tag as junk inherently teaches collecting emails), paragraph [0049] lines 6-8 (sets of training data inherently teaches a collection of email), paragraph [0051] (sets and subsets of training data inherently teaches collection of emails), paragraph [0052] (excluding data inherently teaches the collection of email), paragraph [0066] lines 6-9 (subsets of training data inherently teaches the collection of emails), paragraph [0068] lines 1-5 (subsets of training data inherently teaches collection of emails)) to be used in the benchmark suite.

c) Consider **claim 3**, and as **applied to claim 1 above**, Goodman et al. further disclose customizing emails (abstract lines 9-15 (adding a number to the message score inherently teaches customizing emails), figure 5 (510 computing ash inherently teaches customizing emails), figure 7 (720 excluding features inherently teaches customizing emails), paragraph [0008] lines 5-8 (adding elements of randomization inherently teaches customizing emails), paragraph [0010] lines 12- 14, paragraph [0012] lines 2-4 (random number generated based on contents of the message inherently teaches customizing emails) lines 6-7 (small changes in the contents inherently teaches customizing emails), paragraph [0028] lines 7-15, paragraph [0044] lines 1-2, paragraph [0052] lines 4-9,

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paragraph [0058] lines 11-17, paragraph [0063] lines 12-19, paragraph [0068] lines 5-8) to be used in the benchmark suite.

d) Consider **claim 4**, and as **applied to claim 1 above**, Goodman et al. further disclose testing the benchmark suite for normalizing (figure 2 (220 multiple spam filters inherently teaches normalization of new suites bases on old suites), figure 6 (620), figure 7 (740), paragraph [0014], paragraph [0055] lines 8-11, paragraph [0067] lines 1-4) against prior suites.

e) Consider **claim 6**, and as **applied to claim 1 above**, Goodman et al. further disclose obtaining other user data (abstract 12-15, figure 4, figure 6 (610 620 inherently teaches obtaining other user as it would be necessary to cluster the users and messages), paragraph [0029] lines 1-4, paragraph [0036] lines 8-12, paragraph [0046] lines 3-4, paragraph [0052], paragraph [0057] lines 6-10, paragraph [0062], paragraph [0066] lines 9-17) that may be relevant to manufacturing the benchmark suite.

f) Consider **claim 7**, and as **applied to claim 1 above**, Goodman et al. further disclose presentation of other information (figure 1 (130), figure 3 (320, 340), figure 5 (530), paragraph [0030], paragraph [0031], paragraph [0033] lines 5-10, paragraph [0046] line 3-6, paragraph [0057] lines 7-9) relevant to how the user can analyze the benchmark data.

g) Consider **claim 8**, and as **applied to claim 2 above**, Goodman et al. further disclose collecting emails (figure 7 (710, 720, subset of training data inherently teaches a collection of emails), paragraph [0026] line 3 (training data inherently teaches a collection of emails), paragraph [0027] lines 13-17 (capture and tag as junk inherently teaches collecting emails), paragraph [0049] lines 6-8 (sets of training data inherently teaches a collection of email), paragraph [0051] (sets and subsets of training data inherently teaches collection of emails), paragraph [0052] (excluding data inherently teaches the collection of email), paragraph [0066] lines 6-9 (subsets of training data inherently

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teaches the collection of emails), paragraph [0068] lines 1-5 (subsets of training data inherently teaches collection of emails)) for benchmarking using a means that can reliably distinguish among categories of email automatically (abstract lines 7-8 lines 11-12, figure 2 (250), figure 3 (350), figure 5 (540), figure 6 (630 650), figure 7 (720 750), paragraph [0004], paragraph [0009], paragraph [0010] line 11, paragraph [0013], paragraph [0014], paragraph [0026] line 3, paragraph [0027] lines 13-17, paragraph [0028] lines 7-15, paragraph [0029] lines 7-11, paragraph [0032] lines 6-10, paragraph [0035] lines 4-9 lines 12-15, paragraph [0038] lines 3-4, paragraph [0048], paragraph [0049] lines 4-6, paragraph [0052], paragraph [0055] lines 4-6, paragraph [0057] line 12, paragraph [0058] line 2-3, paragraph [0064] lines 10-12, paragraph [0065] line 5, paragraph [0066] line 8, paragraph [0068] line 5).

h) Consider **claim 9**, and as applied to **claim 3** above, Goodman et al. further disclose inserting a text string in the body of the benchmark emails (abstract lines 12-15, figure 7 (720), paragraph [0010] lines 12-14, paragraph [0012] lines 2-4 lines 6-7, paragraph [0028] lines 7-15) that permits different email categories to be reliably sorted for analysis of the performance of the email filter.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. **Claim 5** rejected under 35 U.S.C. 103(a) as being unpatentable over **Goodman et al. (US Patent Publication # US 2005/0015454 A1)**.

a) Consider **claim 5**, and as **applied to claim 1** above, Goodman et al. clearly show and disclose the claimed invention except obtaining a passcode for validation.

Nonetheless, the Examiner takes Official Notice of the fact that it is notoriously well known in the art to perform the claimed step of validating an email address using a “passcode” such as those used in Challenge-Response authentication or CAPTCHA (Completely Automated Public Turing test to tell Computers and Humans Apart). Wherein the purpose of the code is to require a response from a human user.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the claimed step, as known in the art, in the method taught by Goodman et al. for the purpose of validating an email address and confirming a human user.

### *Conclusion*

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Goodman et al. (US Publication # US 2004/0215977 A1) discloses: "Intelligent Quarantining for Spam Prevention"
- Murphy et al. (US Publication # US 2006/0015561 A1) discloses: "Incremental Anti-Spam Lookup and Update Service"
- Rounthwaite et al. (US Publication # US 2004/0215977 A1) discloses: "Feedback Loop for Spam Prevention"
- Tyler, Joseph C. (US Publication # US 2004/0006747 A1) discloses: "Electronic Publishing System and Method"

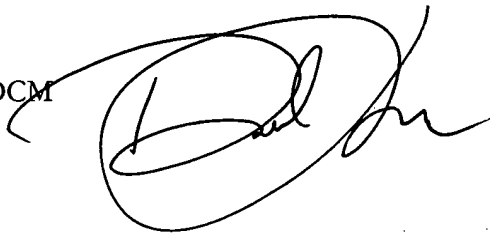
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Murray whose telephone number is (571)-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571)-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DCM



  
RAFAEL PEREZ-GUTIERREZ  
SUPERVISORY PATENT EXAMINER

1/19/07